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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/087,489	03/01/2002	Alan E. Shluzas	A31-6015	3030

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EXAMINER

RAMANA, ANURADHA

ART UNIT PAPER NUMBER

3732

DATE MAILED: 05/18/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/087,489	SHLUZAS, ALAN E.	
	Examiner	Art Unit	
	Anu Ramana	3732	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 March 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 5-41 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 5-7 and 16-31 is/are allowed.
- 6) ☒ Claim(s) 1,8-15 and 32-41 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>3/23/04</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on March 23, 2004 has been entered.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 32-40 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 32, it is unclear what structure is being referred to by the phrase "said member including means for relativespacer." It appears that the member by itself performs the stated function.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 8-15 and 32-41 are rejected under 35 U.S.C. 102(e) as being anticipated by Horvath et al. (US 6,440,137).

Horvath et al. disclose a fastening apparatus with a longitudinal member 40; a fastener 110 engageable with a bone portion and connecting the longitudinal member to the bone portion with a first part spherical surface 116 engageable with housing 10 and a second part spherical surface 112 engageable with a washer or spacer 120, the housing 10 having a first passage 30 through which the longitudinal member 40 extends and a second passage extending transverse to the first passage through which the fastener 110 extends being positionable in any one of a plurality of angular positions relative to the longitudinal axis of the second passage, and the spacer 120 being positioned in the second passage of housing 10; an upset or "member" 12 fixedly connected to housing 10 and extending into engagement with grooves 122 of spacer 120 to maintain the spacer in frictional engagement with fastener 110 to prevent relative movement between fastener 110 and housing 10; and a clamping mechanism 50 with a threaded member 70 that clamps longitudinal member 40, spacer 120, and housing 10 to prevent relative movement of fastener 110 relative to housing 10 (Figure 4, Figure 5, col. 2, lines 66-67, col. 3, lines 1-43 and col. 4, lines 1-13).

Response to Arguments

Applicant's arguments submitted under "REMARKS" in the response submitted on March 23, 2004 have been fully considered but are not persuasive with respect to claims 1 and 8-15 and 32-41.

Regarding Applicant's arguments that Horvath et al. do not describe or suggest that the upsets 12 prevent relative movement between body (or "housing") 10 and the shaft or fastener 110 when rod 40 is disengaged from washer or "spacer" 120 and the spacer engages the fastener, it is the Examiner's position that whether longitudinal member 40 is disengaged from or engaged with spacer 120 has no effect on the position of fastener 110 with respect to housing 10 as long as fastener 110 is engaged with spacer 120, just like Applicant's claimed invention.

The upsets 12 of Horvath et al. are formed by forcing material at the bottom of holes 11 in housing 10 into opposing grooves 122 of "spacer" 120 (see col. 3, lines 25-41). Therefore, spacer 120 is fixed relative to housing 10 regardless of whether longitudinal member 40 is

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engaged with or disengaged from spacer 120. Horvath et al. clearly state that threaded shaft or fastener 110 is in structurally sound interconnection with spacer 120 inherently making these elements inseparable although they may be in rotational communion (col. 3, lines 43-44 and col. 4, lines 1-13). Thus, as long as fastener 110 is engaged with spacer 120 by the upsets 12, the position of fastener 110 is fixed with respect to housing 10, regardless of whether longitudinal member 40 is engaged with or disengaged from spacer 120.

Applicant's arguments with respect to claims 8-15 and 33-40 fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references.

Allowable Subject Matter

Claims 5-7 and 16-31 are allowed.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anu Ramana whose telephone number is (703) 306-4035. The examiner can normally be reached Monday through Friday between 8:00 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kevin Shaver can be reached at (703) 308-2582. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

AR *Anu Ramana*
May 15, 2004

Pedro Philogene
PEDRO PHILOGENE
PRIMARY EXAMINER